

Claims 1-56 are pending in the present application, of which claims 1-24 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action rejects claim 27 under 35 U.S.C. § 112, second paragraph, asserting that "it is unclear how the semiconductor device can be one of the mentioned devices because the mentioned devices include many more components than simply a semiconductor layer" (page 2, Paper No. 022405). The Applicants respectfully submit that claim 27 is clear and definite. The term "semiconductor device" is a general term meant to describe a device comprising a semiconductor. Also, it is noted that the independent claims are directed to a "method of manufacturing a semiconductor device comprising the steps of ..." (emphasis added). That is, "comprising" is open-ended and the scope of the claims should not be limited to specific steps or elements recited in each of the independent claims. As such, the "semiconductor device" in claim 27 could be a device comprising a semiconductor where the device is one from the group recited in claim 27 and described, for example, at Figures 13A to 13F. In other words, for example, a video camera is one of many types of semiconductor devices included in the scope of the independent claims. Further, it is noted that the Official Action itself appears to appreciate the scope of claim 27 as evidenced by the arguments presented at page 4 of the Official Action. Therefore, the Applicants respectfully submit that claim 27 is definite and the scope of claim 27 would be understandable to one of ordinary skill in the art. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 112 are in order and respectfully requested.

The Official Action rejects claims 1-18, 25, 26 and 28-50 as anticipated by JP 07-038113 to Morosawa. The Applicants respectfully traverse the rejection because the Official Action has not established an anticipation rejection.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a

single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Applicants respectfully submit that an anticipation rejection cannot be maintained against the independent claims of the present application. The Official Action contends that Morosawa discloses "leveling the surface of the semiconductor film by heating in a nitrogen atmosphere with a concentration less than 10 ppm oxygen." However, Morosawa does not disclose the leveling step after removal of an oxide film (claims 1-6 and 13-24) or the leveling step after treatment with hydrofluoric acid (claims 7-12). Since the prior art fails to disclose each and every limitation of the claims, an anticipation rejection cannot be maintained and favorable reconsideration is requested.

Should the Official Action contend that the treatment with NH<sub>3</sub> and N<sub>2</sub> plasma at 250° C (paragraph [0011] of Morosawa) to decrease dangling bond corresponds to the claimed leveling step, it is noted that in accordance with the claimed invention, the leveling step is performed after removal of an oxide film (or the leveling step is performed after treatment with hydrofluoric acid) and the step for forming a gate insulating film is performed after the leveling step in all independent claims. To the contrary, Morosawa performs the step for forming a gate insulating film and the step for decreasing dangling bonds simultaneously, and therefore, it appears that Morosawa does not disclose or suggest at least this feature of the present claims.

The Official Action rejects claim 27 as obvious based on Morosawa and claims 19-24 and 51-56 as obvious based on the combination of Morosawa and U.S. Patent No. 5,712,191 to Nakajima et al. The Applicants respectfully traverse the rejection because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the

prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Please incorporate the arguments above with respect to the deficiencies in Morosawa. Nakajima does not cure the deficiencies in Morosawa. The Official Action relies on Nakajima to allegedly teach "a laser light having a line shaped cross section elongated in one direction" (page 4, Paper No. 022405). However, Morosawa and Nakajima, either alone or in combination, do not disclose or suggest the leveling step after removal of an oxide film (claims 1-6 and 13-24) or the leveling step after treatment with hydrofluoric acid (claims 7-12).

Since Morosawa and Nakajima do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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